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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,034	03/21/2001	Liang Chen	25061A	3539

22889 7590 02/18/2004

OWENS CORNING  
2790 COLUMBUS ROAD  
GRANVILLE, OH 43023

EXAMINER
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WILSON, DONALD R

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 02/18/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

<b>Office Action Summary</b>	<b>Application No.</b> 09/814,034	<b>Applicant(s)</b> CHEN ET AL.	
	<b>Examiner</b> Donald R Wilson	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-19, 21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-19, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7</u> | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

***Status of Application***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/12/04 has been entered.
2. Applicant's election of the inventions of Group III, now Claims 17-19 and 21-22 in Paper No. 5, and the species of, (a) glycerine as the polyhydroxy cross-linking agent, and (b) sodium hypophosphite as the further cure accelerator, in Papers No. 5 and 10 remain in effect.

***Response to Amendment***

3. Applicant's amendment filed 1/12/04, has been fully considered with the following results.
4. The amendment overcomes the rejection under 35 U.S.C. § 112, second paragraph, which is withdrawn.
5. The amendment is not deemed to be persuasive in overcoming the prior art rejection and the rejection is maintained for reasons discussed below.

***Previously Cited Statutes***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

***Objection to New Matter***

7. The amendment filed 1/12/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

There appears to be no basis in the specification as filed for the amendment to Claim 1 which now recites that the polyhydroxy cross-linking agent contains no more than one nitrogen.

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The express exclusion of certain elements implies the permissible inclusion of all other elements not so expressly excluded which clearly demonstrates that the introduction of negative limitations not explicitly supported by the specification as originally filed do in fact introduce new concepts and are therefore new matter. Any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). See M.P.E.P. § 2173.05(i). The mere absence of a positive recitation is not basis for an exclusion.

8. Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112, First Paragraph***

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claims 17-19 and 21-22 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter in question is that referred to in the objection to new matter.

***Claim Rejections - 35 USC § 102(b)/§ 103(a)***

11. Claims 17-19 and 21-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Arkens'213. The basis of this rejection was stated in Detailed Action § 25-29 of the Office Action of 9/9/02 and has been further discussed in Detailed Action § 12-15 of the Office Action of 4/22/03.

12. In regards to the new claim limitation of the composition being suitable for use as a binder, (i) without adding a separate accelerating agent, and (ii) said polyhydroxyl cross-linking agent containing no more than one nitrogen, such is within the teachings of Arkens'213. First, Arkens'213 clearly teaches "[a] specific embodiment of the invention disclosed is the use of hypophosphorous acid and its salts as the chain transfer agent in making the polyacrylic acid, the purpose being to incorporate the phosphorous

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containing cure accelerator and the polyacid in the same molecule" (col. 5, lines 11-18, underlining added). Thus, one of ordinary skill in the art would readily envisage that if the purpose was to incorporate the cure accelerator into the polymer, then a cure accelerator would not have to be separately added. Even if the patent taught that a cure accelerator was also separately added, which it does not, the instant claims would still be anticipated and/or obvious, because the compositions would still meet the limitation of being suitable for use as a component in a binder without adding a separate cure accelerator. Additionally, glycerol as the polyhydroxyl containing cross-linking agent does not contain any nitrogen and is taught as has been pointed out in the first Office Action.

13. It is also noted that Arkens'213 teaches that the cure accelerator may be an addition polymer of acrylic acid formed in the presence of sodium hypophosphite (col. 6, lines 29-51). Such a cure accelerator in the presence of another polyacrylic acid and a polyol cross-linking agent would also meet the limits of the claims.

14. Applicant's arguments concerning the use of highly reactive polyols which preferably contain two or more nitrogen atoms when a cure accelerator is not present, is not relevant because it is not a teaching relied upon in the rejection.

#### ***Art of Interest/Technological Background***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Newly cited EP'086 is equivalent to Arkens'213 used in the above rejection. Newly cited EP'818 is equivalent to the previously considered Hughes'361. Newly cited EP'727 and EP'728 could both be used to reject the instant claims, but the teachings are cumulative to those of the applied Arkens'213.

#### ***Request for Interview***

16. Applicant's request for an interview is noted. However, the time to request an interview is not when the Examiner is in the middle of acting on applicant's amendment. If applicant still wishes an interview he should make an appointment with the Examiner by telephone, or file a form PTOL 413A (see M.P.E.P. § 713.01 - Scheduling and Conducting an Interview).

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***Future Correspondence***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald R Wilson whose telephone number is 571-272-1113.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 571-272-1114. The fax phone numbers for the organization where this application or proceeding is assigned is (703) 872-9306 for regular communications. The unofficial direct fax phone number to the Examiner's desk is 571-273-1113.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1700.

A handwritten signature in black ink, appearing to read 'DWilson', with a long horizontal flourish extending to the right.

Donald R Wilson  
Primary Examiner  
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